

HONORABLE RICHARD A. JONES

UNITED STATES DISTRICT COURT
WESTERN DISTRICT OF WASHINGTON
SEATTLE DIVISION

BLUETOOTH SIG, INC., a Delaware
corporation,

Plaintiff,

v.

FCA US LLC, a Delaware limited liability
company,

Defendant.

Case No. 2:18-cv-01493

**BLUETOOTH SIG, INC.’S ANSWER TO
FCA US LLC’S COUNTERCLAIMS FOR
CANCELLATION**

Plaintiff Bluetooth SIG, Inc. (“Plaintiff” and/or the “SIG”) hereby responds to Defendant FCA US LLC’s (“Defendant” and/or “FCA”) Counterclaims for Cancellation filed on October 7, 2019 (ECF No. 53). The SIG does not respond to the headers in FCA’s Counterclaims. The use of the headers of the Counterclaims in this Answer is done solely for convenience, and in no way constitutes an admission of any allegation contained in such headers. The SIG denies any and all allegations that are not expressly admitted. With respect to each of the individually numbered paragraphs of the Counterclaims, the SIG answers as follows.

FACTS COMMON TO ALL GROUNDS FOR CANCELLATION

1. The SIG admits the allegations in Paragraph 1 of the Counterclaims.

2. The SIG denies the allegations in Paragraph 2 of the Counterclaims.

Prosecution History of the BLUETOOTH Certification Marks

3. The SIG admits the allegations in Paragraph 3 of the Counterclaims.

4. The SIG admits the allegations in Paragraph 4 of the Counterclaims.

5. The SIG admits that the Trademark Examining Attorney assigned to the applications to register the BLUETOOTH Marks initially refused registration of the BLUETOOTH word mark pursuant to Section 2(e)(1), 15 U.S.C. § 1052(e)(1), and that Paragraph 5 of the Counterclaims purports to contain excerpts of a document identified as Exhibit 1. To the extent that Paragraph 5 purports to quote, paraphrase, or characterize a document, that document speaks for itself and the SIG denies any characterization of that document contained in this paragraph.

6. The SIG admits that it had not overcome the Trademark Examining Attorney's objections by September 27, 2001, and that Paragraph 6 of the Counterclaims purports to contain references to a document identified as Exhibit 2. To the extent that Paragraph 6 purports to quote, paraphrase, or characterize a document, that document speaks for itself and the SIG denies any characterization of that document contained in this paragraph.

7. The SIG admits that it amended its applications to seek registration of the BLUETOOTH and BLUETOOTH & Design marks as certification marks, and that Paragraph 7 of the Counterclaims purports to contain excerpts of a document identified as Exhibit 3. To the extent that Paragraph 7 purports to quote, paraphrase, or characterize a document, that document speaks for itself and the SIG denies any characterization of that document contained in this paragraph.

8. The SIG admits the allegations in Paragraph 8 of the Counterclaims.

1 **Prosecution History of the Design Mark**

2 9. The SIG admits that Paragraph 9 of the Counterclaims purports to contain
 3 excerpts of a document identified as Exhibit C to Dkt. 1. To the extent that Paragraph 9 purports
 4 to quote, paraphrase, or characterize a document, that document speaks for itself and the SIG
 5 denies any characterization of that document contained in this paragraph. The SIG admits the
 6 remaining allegations in Paragraph 9 of the Counterclaims.

7 10. The SIG admits that on February 26, 2018, it submitted a combined declaration of
 8 use and renewal of registration for its Design Mark, and that Paragraph 10 of the Counterclaims
 9 purports to contain excerpts of documents identified as Exhibits 4 and 5. To the extent that
 10 Paragraph 10 purports to quote, paraphrase, or characterize documents, those documents speak
 11 for themselves and the SIG denies any characterization of those documents contained in this
 12 paragraph.

13 11. The SIG admits that on March 24, 2018, the Post Registration Division of the
 14 USPTO issued an Office Action rejecting the SIG's specimen of use for the goods in Class 12 in
 15 its registration for the Design Mark, and that Paragraph 11 of the Counterclaims purports to
 16 contain excerpts of a document identified as Exhibit 6. To the extent that Paragraph 11 purports
 17 to quote, paraphrase, or characterize a document, that document speaks for itself and the SIG
 18 denies any characterization of that document contained in this paragraph.

19 12. The SIG admits that Paragraph 12 of the Counterclaims purports to contain
 20 excerpts of a document identified as Exhibit 7. To the extent that Paragraph 12 purports to
 21 quote, paraphrase, or characterize a document, that document speaks for itself and the SIG denies
 22 any characterization of that document contained in this paragraph. The SIG denies the remaining
 23 allegations in Paragraph 12 of the Counterclaims.

24 13. The SIG admits that Paragraph 13 of the Counterclaims purports to contain
 25 excerpts of a document identified as Exhibit 7. To the extent that Paragraph 13 purports to
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1 quote, paraphrase, or characterize a document, that document speaks for itself and the SIG denies
2 any characterization of that document contained in this paragraph.

3 14. The SIG admits the allegations in Paragraph 14 of the Counterclaims.

4 **Plaintiff's Failure to Control the Use of the BLUETOOTH Marks**

5 15. The SIG denies the allegations in Paragraph 15 of the Counterclaims.

6 16. The SIG denies the allegations in Paragraph 16 of the Counterclaims.

7 **Plaintiff's Engagement in the Production or Marketing of Goods or Services to Which One
8 or More of Its Certification Marks Are Applied**

9 17. The SIG admits that Paragraph 17 of the Counterclaims purports to contain
10 references to a document identified as Exhibit 4. To the extent that Paragraph 17 purports to
11 quote, paraphrase, or characterize a document, that document speaks for itself and the SIG denies
12 any characterization of that document contained in this paragraph.

13 18. The SIG states that Paragraph 18 of the Counterclaims sets forth conclusions of
14 law, such that no response is required. To the extent a response is required, the SIG denies the
15 allegations in Paragraph 18.

16 19. The SIG admits that Paragraph 19 of the Counterclaims purports to contain
17 references to a document identified as Exhibit 5. To the extent that Paragraph 19 purports to
18 quote, paraphrase, or characterize a document, that document speaks for itself and the SIG denies
19 any characterization of that document contained in this paragraph. The SIG denies the remaining
20 allegations in Paragraph 19 of the Counterclaims.

21 20. The SIG states that Paragraph 20 of the Counterclaims sets forth conclusions of
22 law, such that no response is required. To the extent a response is required, the SIG denies the
23 allegations in Paragraph 20.
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FIRST COUNTERCLAIM FOR CANCELLATION

(U.S. Reg. Nos. 2,909,356 and 2,911,905)

**FAILURE TO CONTROL THE USE OF A CERTIFICATION MARK
UNDER 15 U.S.C. § 1064(5)(A)**

21. The SIG incorporates by reference the preceding paragraphs of this Answer as if set forth fully herein.

22. The SIG states that Paragraph 22 of the Counterclaims sets forth conclusions of law, such that no response is required.

23. The SIG denies the allegations in Paragraph 23 of the Counterclaims.

24. The SIG denies the allegations in Paragraph 24 of the Counterclaims.

25. The SIG denies the allegations in Paragraph 25 of the Counterclaims.

SECOND COUNTERCLAIM FOR CANCELLATION

(U.S. Reg. No. 3,389,311)

ABANDONMENT UNDER 15 U.S.C. § 1064(3)

26. The SIG incorporates by reference the preceding paragraphs of this Answer as if set forth fully herein.

27. The SIG states that Paragraph 27 of the Counterclaims sets forth conclusions of law, such that no response is required.

28. The SIG states that Paragraph 28 of the Counterclaims sets forth conclusions of law, such that no response is required.

29. The SIG denies the allegations in Paragraph 29 of the Counterclaims.

30. The SIG denies the allegations in Paragraph 30 of the Counterclaims.

31. The SIG denies the allegations in Paragraph 31 of the Counterclaims.

THIRD COUNTERCLAIM FOR CANCELLATION

(U.S. Reg. Nos. 2,909,356 and 2,911,905)

**ENGAGING IN THE PRODUCTION OR MARKETING OF GOODS OR
SERVICES TO WHICH A CERTIFICATION MARK IS APPLIED
UNDER 15 U.S.C. § 1064(5)(B)**

32. The SIG incorporates by reference the preceding paragraphs of this Answer as if set forth fully herein.

33. The SIG states that Paragraph 33 of the Counterclaims sets forth conclusions of law, such that no response is required.

34. The SIG admits that Paragraph 34 of the Counterclaims purports to contain references to and excerpts of documents identified as Exhibits 4 and 5. To the extent that Paragraph 34 purports to quote, paraphrase, or characterize documents, those documents speak for themselves and the SIG denies any characterization of those document contained in this paragraph. The SIG is not required to respond to the conclusion of law set forth in Paragraph 34 of the Counterclaims.

35. The SIG denies the allegations in Paragraph 35 of the Counterclaims.

36. The SIG denies the allegations in Paragraph 36 of the Counterclaims.

37. The SIG denies the allegations in Paragraph 37 of the Counterclaims.

1 Dated: October 28, 2019

/s/ Peter J. Willsey

Peter J. Willsey (*pro hac vice*)
Vincent J. Badolato (*pro hac vice*)
BROWN RUDNICK LLP
601 Thirteenth Street NW, Suite 600
Washington, DC 20005
Tel.: (202) 536-1700
Email: pwillsey@brownrudnick.com
vbadolato@brownrudnick.com

Honieh Udenka (*pro hac vice*)
BROWN RUDNICK LLP
2211 Michelson Drive, Suite 700
Irvine, CA 92612
Tel.: (949) 440-0238
Email: hudenka@brownrudnick.com

Stephanie Calnan (*pro hac vice*)
BROWN RUDNICK LLP
One Financial Center, 18th Floor
Boston, MA 02111
Tel.: (617) 856-8149
Email: scalnan@brownrudnick.com

/s/ Christopher B. Durbin
Christopher B. Durbin (WSBA #41159)
Jeffrey D. Lombard (WSBA #50260)
COOLEY LLP
1700 Seventh Avenue, Suite 1900
Seattle, WA 98101-1355
Tel.: (206) 452-8700
Email: cdurbin@cooley.com
jlombard@cooley.com

Attorneys for Plaintiff BLUETOOTH SIG, INC.

CERTIFICATE OF SERVICE

I hereby certify that on October 28, 2019, I caused a true and correct copy of the foregoing BLUETOOTH SIG, Inc.'s Answer to FCA US LLC's Counterclaims for Cancellation to be filed with the Court using the CM/ECF system, which will send notification of such filing to CM/ECF participants.

/s/ Christopher B. Durbin
Christopher B. Durbin